

Notice of Allowability

Application No.

09/409,524

Applicant(s)

LEE, EUGENE M.

Examiner

Jonathan Ouellette

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 6/27/2005.
2. ☒ The allowed claim(s) is/are 1,5-43 and 52-60.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

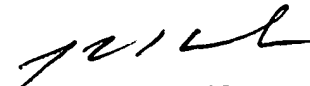
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☒ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date 20050805
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 20050909
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

DETAILED ACTION

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.
2. Authorization for this examiner's amendment was given in a telephone interview with the Attorney of record, Cynthia Nicholson, on 9/9/2005 (Reg. No 36,880).
3. The application has been amended as follows:
5. Claim 1, line 2, change "one" to "two"; line 11, change "one" to "two".
6. Claim 5, line 9, change "one" to "two"; line 10, change "jurisdiction" to "jurisdictions"; line 12, delete "at least one"; line 13, change "jurisdiction" to "jurisdictions"; line 20, delete "at least one"; line 21, change "jurisdiction" to "jurisdictions".
7. Claim line 2, change "one" to "two"; line 2, change "jurisdiction" to "jurisdictions"
8. Claim 8, line 2, change "one" to "two"; line 2, change "jurisdiction" to "jurisdictions"; line 6, change "one" to "two"; line 7, change "jurisdiction" to "jurisdictions".
9. Claim 9, line 2, change "one" to "two"; line 2, change "jurisdiction" to "jurisdictions".
10. Claim 11, line 4, change "one" to "two"; line 4, change "jurisdiction" to "jurisdictions".
11. Claim 12, line 4, delete "at least one"; line 4, change "jurisdiction" to "jurisdictions".
12. Claim 15, line 4, change "one" to "two"; line 4, change "jurisdiction" to "jurisdictions"; line 16, delete "at least one"; line 17, change "jurisdiction" to "jurisdictions".
13. Claim 16, line 3, change "one" to "two"; line 5, delete "at least one";

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14. Claim 17, line 2, delete "at least one"; line 3, change "jurisdiction" to "jurisdictions".
15. Claim 18, line 2, delete "at least one"; line 3, change "jurisdiction" to "jurisdictions"; line 5, change "one" to "two"; line 6, change "selection" to "selections"; line 7, change "jurisdiction" to "jurisdictions".
16. Claim 20, line 2, delete "at least one"; line 2, change "jurisdiction" to "jurisdictions"; line 9, change "jurisdiction" to "jurisdictions".
17. Claim 22, line 9, change "jurisdiction" to "jurisdictions".
18. Claim 23, line 4, change "one" to "two".
19. Claim 24, line 2, change "one" to "two".
20. Claim 25, line 3, add "and corresponding associates" after "target jurisdictions"; line 5, add "and corresponding associates" after "target jurisdictions"; line 11, change "jurisdiction" to "jurisdictions".
21. Claim 33, line 3, change "one" to "two"; line 5, change "at least one" to "the"; line 5, change "jurisdiction" to "jurisdictions"; line 11, change "jurisdiction" to "jurisdictions"; line 13, change "jurisdiction" to "jurisdictions"; line 15, change "jurisdiction" to "jurisdictions".
22. Claim 37, line 5, change "one" to "two".
23. Claim 41, line 3, add "and corresponding associates" after "target jurisdictions"; line 8, add "and corresponding associates" after "target jurisdictions"; line 11, add "by the corresponding associates" after "target jurisdictions".
24. Claim 43, line 3, change "one" to "two"; line 5, change "one" to "two".
25. Cancel Claims 44-51
26. Claim 52, line 9, add "for use with a computer" after "medium".

- 27. Claim 54, line 10, change "one" to "two".
- 28. Claim 56, line 3, change "jurisdiction" to "jurisdictions".
- 29. Claim 57, line 1, change "one" to "two".
- 30. Claim 58, line 3, delete "at least one"; line 3, change "jurisdiction" to "jurisdictions".
- 31. Claim 60, line 4, change "jurisdiction" to "jurisdictions".

Response to Amendment

- 32. Claims 2-4 have been previously cancelled, Claims 44-51 are cancelled by Examiner's amendment; therefore Claims 1, 5-43, and 52-60 are pending in application 09/409,524.

Claim Rejections - 35 USC § 112

- 33. The rejection of Claims 58-60 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, is withdrawn due to Applicant's arguments.

Claim Rejections - 35 USC § 103

- 34. The rejection of Claims 1, 5-8, 10-16, 20-22, 24-39, 40-54, and 56-57 under 35 U.S.C. 103(a) as being unpatentable over InventNet.com (www.inventnet.com, retrieved from Internet Archive WayBack Machine <www.archive.org>, date range: 12/3/1998-2/9/1999), in view of Legalstar.com (www.legalstar.com, retrieved from Internet Archive WayBack Machine <www.archive.org>, date range: 12/2/1998-12/7/1998), and further in view of IWAI et al. (US 5,175,681), is withdrawn due to Applicant's amendments and Examiner's amendments.

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35. The rejection of Claims 9, 17-19, and 23 under 35 U.S.C. 103(a) as being unpatentable over InventNet.com, in view of IWAI et al., and further in view of Brown, Pinnisi & Michaels, PC (www.lightlink.com\bbm, retrieved from Internet Archive Wayback Machine <www.archive.org>, date range: 2/24/1998-2/18/1999), is withdrawn due to Applicant's amendments and Examiner's amendments.
36. The rejection of Claims 54 and 55 under 35 U.S.C. 103(a) as being unpatentable over Legalstar.com, in view of InventNet.com, and further in view of IWAI, is withdrawn due to Applicant's amendments and Examiner's amendments.

Allowable Subject Matter

37. Claims 1, 5-43, and 52-60 are allowed.
38. The following is an examiner's statement of reasons for allowance:
39. As per **independent Claim 1**, the prior art does not teach or suggest a method of operating an information service to facilitate preparation of intellectual property documents suitable for filing in *two* or more of plural target jurisdictions the method comprising: registering for each of plural associates, a computer readable encoding of a plurality of form documents corresponding to target jurisdiction and associate specifications, wherein the form documents include fields defined for completion of matter-specific information; distributing at least a portion of the form documents to an originating filer for use in preparation of the intellectual property documents suitable for filing by respective ones of the associates, wherein the distribution is at least one of (i) responsive to selection by the originating filer of *two* or more of the target jurisdictions and, for each selected target jurisdiction, a respective one of the

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associates, and (ii) periodic supply to the originating filer of the computer readable encoding of at least a portion of the form documents for each of plural associates; receiving filing documents from the originating filer, wherein the filing documents comprise at least a portion of the form documents completed with matter-specific information from the originating filer; and automatically determining, by a computer, responsive to the filing documents, respective associates for receipt of the filing documents, and forwarding the filing documents to the respective associates.

40. As per **independent Claim 5**, the prior art does not teach or suggest an information system for transacting an intellectual property filing with plural targets therefor, the information system comprising: the intellectual property filing portal responsive to a selection at the originating node of at least *two* target jurisdictions and at least one associate corresponding thereto for the intellectual property filing, automatically supplying the originating node with particularized requirements of the selected target jurisdictions and at least one associate, the intellectual property filing portal further responsive to receipt via the network of one or more intellectual property filings prepared in accordance with the particularized requirements of the selected target jurisdictions and at least one associate, supplying corresponding ones of the target nodes with respective portions of the received one or more intellectual property filings for filing by respective ones of the selected at least one associate in respective ones of the selected target jurisdictions.

41. As per **independent Claim 15**, the prior art does not teach or suggest a method of operating an intellectual property filing portal for servicing intellectual property filing transactions using a network accessible information service, the method comprising: responsive to a

selection by a user of at least *two* target jurisdictions and at least one associate corresponding thereto, supplying the user, from the information service via the network, with a computer readable encoding of one or more form documents, wherein the form documents are specific to the selected target jurisdictions and at least one associates and wherein the form documents include fields defined for completion of matter-specific information; and receiving from the user, at the information service via the network, one or more documents suitable for filing completed with matter-specific information for a corresponding matter, and in accordance with the one or more form documents, automatically determining, by a computer, the at least one associate corresponding thereto, and forwarding same to the corresponding at least one associates for filing in the selected target jurisdictions.

42. As per **independent Claim 22**, the prior art does not teach or suggest a computer implemented method of operating an intellectual property filing service, the method comprising: receiving at a computer, a transmission from a user, having at least one selection of two or more target jurisdictions and corresponding associates for an intellectual property filing; in response to the at least one selection, supplying a transmission from the computer to the user, of two or more target jurisdictions and associate-specific documents for completion for each jurisdiction; receiving, at the computer, the completed two or more target jurisdiction and associate-specific documents; and forwarding, from the computer, respective ones of the target jurisdictions and associate-specific documents, to each of the selected associates for filing in respective of the selected two or more target jurisdictions.

43. As per **independent Claim 25**, the prior art does not teach or suggest a computer implemented method for initiating filing of one or more intellectual property related

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documents, said method comprising: selecting two or more target jurisdictions and corresponding associates from amongst a set of supported jurisdictions; and responsive to each selected target jurisdiction and corresponding associate, obtaining a computer readable encoding of one or more form documents, wherein the one or more form documents are specific to the target jurisdiction and to a respective associate therefor; and supplying at least a portion of a set of filing documents in accordance with the one or more form documents, for transfer to the respective associate suitable for filing in the selected target jurisdictions.

44. As per **independent Claim 33**, the prior art does not teach or suggest a computer implemented method for initiating filing of one or more intellectual property related documents, said method comprising: selecting *two* or more target jurisdictions from amongst a set of supported jurisdictions; for the selected target jurisdictions, selecting from amongst one or more attorneys or agents available therefor; and for each selected target jurisdiction, automatically transforming, by a computer, a computer readable encoding of intellectual property application data to a format appropriate for filing and consistent with requirements of the selected target jurisdictions, the transforming being in accordance with a computer readable encoding of filing requirements for the selected target jurisdictions; and electronically transmitting the transformed computer readable encoding to an attorney or agent for filing in the selected target jurisdictions.

45. As per **independent Claim 41**, the prior art does not teach or suggest a computer implemented method of preparing one or more intellectual property filings, said method comprising: receiving, at a target computer, a selection of two or more target jurisdictions and corresponding associates from an originating computer system; responsive to the receipt

of the selection, supplying, from the target computer to the originating computer system, a computer readable encoding of filing requirements for the selected two or more target jurisdictions and corresponding associates; and receiving, at the target computer, in computer readable form, at least one document suitable for filing in respective ones of the selected two or more target jurisdictions by the corresponding associates and prepaid at the originating computer system in accordance with the computer readable encoding of filing requirements.

46. As per **independent Claim 52**, the prior art does not teach or suggest a computer program product encoded in a computer readable medium, for use with a computer, the computer program product comprising: selection code executable to select two or more target jurisdictions and respective associates from amongst a set of target jurisdictions and associates therefor; retrieval code executable to retrieve, in accordance with the selection, a computer readable encoding of target jurisdiction- and associate-specific filing requirements for the two or more target jurisdictions; documents preparation code executable to prepare target jurisdiction- and associate-specific documents in accordance with the retrieved requirements; and filing initiation code executable to transmit the prepared documents for filing by the selected one or more associates in the selected two or more target jurisdictions.
47. As per **independent Claim 54**, the prior art does not teach or suggest a method of making a computer readable encoding of one or more target jurisdiction- and associate-specific form documents, the method comprising: maintaining a data store of target jurisdiction- and associate-specific form documents for transacting an intellectual property filing in the target jurisdictions using respective of the associates; encoding, based on contents of the data store, an enumeration, for transmission to a computer, of at least a subset of the target jurisdiction

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and respective of the associates therefor; receiving a selection of *two* or more of the target jurisdictions and respective associates; automatically retrieving, by a computer, based on the selection, corresponding of the target jurisdiction- and associate-specific form documents; and automatically encoding, by the computer, as a response to the selection for transmission to the computer, the retrieved target jurisdiction- and associate-specific form documents.

48. As per **independent Claim 56**, the prior art does not teach or suggest an intellectual property filing preparation system comprising: means for selecting two or more target jurisdiction and respective associates; means for obtaining form documents specific to each selected target jurisdiction and associate; means for completing the obtained form documents in accordance with matter specific data; and means for automatically transmitting a technical documents and respective of the completed form documents for filing by the selected associates.

49. **InventNet** (www.inventnet.com, retrieved from Internet Archive WayBack Machine <www.archive.org>, date range: 12/3/1998-2/9/1999) discloses a method of operating an information service to facilitate preparation of intellectual property documents suitable for filing in one or more of plural target jurisdictions the method comprising (pgs. 1-6): registering for each of plural associates (pgs. 7-9, Patent Attorney Directory), at least one target jurisdiction (pg. 7, US area codes, Australia, Caribbean, etc.) and a computer readable encoding of a plurality of form documents (pg. 10) (www.inventnet.com).

50. InventNet.com fails to expressly disclose, an information service to facilitate preparation of intellectual property documents suitable for filing in *two* or more of plural target jurisdictions, comprising: registering for each of plural associates, a computer readable encoding of a plurality of form documents corresponding to target jurisdiction and associate

specifications, wherein the form documents include fields defined for completion of matter-specific information; distributing at least a portion of the form documents to an originating filer for use in preparation of the intellectual property documents suitable for filing by respective ones of the associates, wherein the distribution is at least one of (i) responsive to selection by the originating filer of *two* or more of the target jurisdictions and, for each selected target jurisdiction, a respective one of the associates, and (ii) periodic supply to the originating filer of the computer readable encoding of at least a portion of the form documents for each of plural associates; receiving filing documents from the originating filer, wherein the filing documents comprise at least a portion of the form documents completed with matter-specific information from the originating filer; and automatically determining, by a computer, responsive to the filing documents, respective associates for receipt of the filing documents, and forwarding the filing documents to the respective associates, as described in the independent Claims

51. **Legalstar** (www.legalstar.com, retrieved from Internet Archive WayBack Machine <www.archive.org>, date range: 12/2/1998-12/7/1998) discloses providing form documents necessary for preparing and filing intellectual property specific matters and for the development of entity (associate) specific custom designed forms (www.legalstar.com).
52. Legalstar fails to expressly disclose, an information service to facilitate preparation of intellectual property documents suitable for filing in *two* or more of plural target jurisdictions the method comprising: registering for each of plural associates, at least one target jurisdiction and a computer readable encoding of a plurality of form documents corresponding to target jurisdiction and associate specifications, wherein the form documents

include fields defined for completion of matter-specific information; distributing at least a portion of the form documents to an originating filer for use in preparation of the intellectual property documents suitable for filing by respective ones of the associates, wherein the distribution is at least one of (i) responsive to selection by the originating filer of *two* or more of the target jurisdictions and, for each selected target jurisdiction, a respective one of the associates, and (ii) periodic supply to the originating filer of the computer readable encoding of at least a portion of the form documents for each of plural associates; receiving filing documents from the originating filer, wherein the filing documents comprise at least a portion of the form documents completed with matter-specific information from the originating filer; and automatically determining, by a computer, responsive to the filing documents, respective associates for receipt of the filing documents, and forwarding the filing documents to the respective associates, as described in the independent Claims

53. **IWAI** (US 5,175,681) discloses a computerized system used to facilitate the preparation of intellectual property applications for filing in various countries (jurisdictions) (Abstract, C1 L28-45, C3 L21-67).

54. IWAI fails to expressly disclose, an information service to facilitate preparation of intellectual property documents suitable for filing in *two* or more of plural target jurisdictions the method comprising: registering for each of plural associates, at least one target jurisdiction and a computer readable encoding of a plurality of form documents corresponding to target jurisdiction and associate specifications, wherein the form documents include fields defined for completion of matter-specific information; distributing at least a portion of the form documents to an originating filer for use in preparation of the intellectual

property documents suitable for filing by respective ones of the associates, wherein the distribution is at least one of (i) responsive to selection by the originating filer of *two* or more of the target jurisdictions and, for each selected target jurisdiction, a respective one of the associates, and (ii) periodic supply to the originating filer of the computer readable encoding of at least a portion of the form documents for each of plural associates; receiving filing documents from the originating filer, wherein the filing documents comprise at least a portion of the form documents completed with matter-specific information from the originating filer; and automatically determining, by a computer, responsive to the filing documents, respective associates for receipt of the filing documents, and forwarding the filing documents to the respective associates, as described in the independent Claims

55. **BPM** (Brown, Pinnisi & Michaels, PC, www.lightlink.com/bbm, retrieved from Internet Archive Wayback Machine <www.archive.org>, date range: 2/24/1998-2/18/1999) discloses an intellectual property information service with an encoding of at least one paper required by the selected at least one associate (pgs. 7-9, Invention Disclosure Form).
56. BPM fails to expressly disclose, an information service to facilitate preparation of intellectual property documents suitable for filing in *two* or more of plural target jurisdictions the method comprising: registering for each of plural associates, at least one target jurisdiction and a computer readable encoding of a plurality of form documents corresponding to target jurisdiction and associate specifications, wherein the form documents include fields defined for completion of matter-specific information; distributing at least a portion of the form documents to an originating filer for use in preparation of the intellectual property documents suitable for filing by respective ones of the associates, wherein the distribution is at least one

of (i) responsive to selection by the originating filer of *two* or more of the target jurisdictions and, for each selected target jurisdiction, a respective one of the associates, and (ii) periodic supply to the originating filer of the computer readable encoding of at least a portion of the form documents for each of plural associates; receiving filing documents from the originating filer, wherein the filing documents comprise at least a portion of the form documents completed with matter-specific information from the originating filer; and automatically determining, by a computer, responsive to the filing documents, respective associates for receipt of the filing documents, and forwarding the filing documents to the respective associates, as described in the independent Claims

57. The remaining dependent Claims 6-14, 16-21, 23, 24, 26-32, 34-40, 42, 43, 53, 55, and 57-60 are considered allowable, as they are dependent and based off of an allowable independent claim.

58. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion


59. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

60. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization


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where this application or proceeding is assigned (571) 273-8300 for all official communications.

61. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.



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September 19, 2005



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600